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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,608	01/24/2002	Ralph Mitchell Hungerpillar	R105 1010.1	5395

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 08/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,608

Applicant(s)

HUNGERPILLER ET AL.

Examiner

Edward R. Cosimano

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/30/03 & 7/10/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 10 July 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997; and
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000.
 2. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).
 3. Claims 1-8, 24-27, 29-31 & 34-38 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - 3.1 Claims 1-8, 24-27, 29-31 & 36-38 are inoperative and therefore lack utility for the recited purpose of the disclosed and claimed invention, since:
 - A) the preamble of claim 1 states the intended purpose of this claim is the "processing of a plurality of undeliverable mail items", however, the body of the claim merely recites:
 - (1) placing encoding data on a plurality of mail items before mailing;
 - (2) receiving returned undeliverable items of mail; and
 - (3) scanning and processing of the encoded data on the returned undeliverable items of mail.
- Although a skilled artisan would recognize the above process as processing data/information, since this claim stops short of correlating/associating/processing the scanned and processed data with regard to the encoding data placed on the items of mail, one of ordinary skill would not recognize the above process as the processing a plurality of undeliverable mail items as set forth as the intended purpose of the invention. For this reason claims 1-8 & 29-31 are inoperative, vague and indefinite.

Art Unit: 3629

B) the preamble of claim 24 states the intended purpose of this claim is the "processing of a plurality of undeliverable mail items", however, the body of the claim merely recites:

- (1) scanning at least identification data placed on a plurality of mail items;
- (2) capturing the identification data and stored the captured data in a data file; and
- (3) storing the data file in a data base.

Although a skilled artisan would recognize the above process as processing data/information, since this claim stops short of correlating/associating/processing the scanned and processed data with regard to the encoding data placed on the items of mail, one of ordinary skill would not recognize the above process as the processing a plurality of undeliverable mail items as set forth as the intended purpose of the invention. For this reason claims 24-27 & 36-38 are inoperative, vague and indefinite. For as the Court has specifically pointed out, claims must recite utility for the disclosed purpose of the invention, (General Electric Co. V. U.S., 198 U.S.P.Q. 65 (U.S. Court of Claims, 1978), Hanson v. Alpine Valley Ski Area 204 U.S.P.Q. 794 (District Court, E. D. Michigan, N. Div. 1978) and Banning v. Southwestern Bell Telephone C., 182 U.S.P.Q. 683 (SD Tex, 1974)).

3.2 Applicant's inclusion of the process claims 34 & 35, into product/manufacture/machine claims 19 & 20 by dependency creates an improper hybrid claim and hence this combination of claimed subject matter is confusing. This confusion occurs, since it can not be determined if the combined claim is to be classified as only one of the statutory classes of invention, that is:

- A) a process, or
- B) a machine, or
- C) a manufacture, or
- D) a composition of matter.

Note ex parte Lyell, 17 USPQ 2nd 1548 (Bd. Pat. App. & Inter. 1990) and MPEP § 2173.05(p).

Art Unit: 3629

3.3 For the reason given above, claims 34 & 35 lack antecedent basis in claims 19 & 20 from which claims 34 & 35 depend.

3.4 For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

4. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

4.1 Claims 19-23, 34 & 35 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

4.1.1 The instant claims recite a system/device, (claims 19-23, 34 & 35), which has a practical application in the technological arts, and which does not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon. Hence, the instant claims merely define device that contains a series of steps that could be but are not necessarily to be performed on a computer.

4.1.2 It is further noted that applicant has not recited a specific machine since the operations recited in the claim are merely to illustrate the operations of the instant invention since these operations are not in fact implemented by a processor/computer. Hence, applicant envisions the invention as recited in claims 19-23, 34 & 35 as a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure. Such a disembodied storage device is not a specific machine because:

A) it is not associated with a computer in such a way as to cause the computer to operate in a specific manner, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578); and

B) a memory alone can not perform the functions recited within the claims.

Therefore, the recited disembodied storage device, which itself can not perform the functions recited within the claims as the invention, is inoperative and lacks utility for the purpose of the invention.

Art Unit: 3629

4.1.3 In view of the above, the invention recited in claims 19-23, 34 & 35, merely describes an abstract idea of a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure, since a disembodied storage device by itself can not produce a concrete and tangible result by performing the functions recited within the claims as the invention (State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)). Hence, claims 19-23, 34 & 35 do not have a claimed practical application, since the disembodied storage device is inoperative and therefore lacks utility for the purpose of the invention.

4.1.4 Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

4.1.5 Hence, claims 19-23, 34 & 35 are directed to non-statutory subject matter.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements

of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5.1 Claims 1-4, 7-13, 16-23 & 28-33 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Sansone et al (5,925,864).

5.1.1 In regard to claims 1-4, 7-13, 16-23 & 28-33, Sansone et al ('864) disclose a mail processing system that applies both machine readable encoded recipient address information, for example a PDF 417 barcode, and the recipient's address information to an item of mail. The item of mail is then places in the mail delivery system. When an item of mail can not be delivered as addressed, the item of mail is returned to the sender and the machine readable information and recipient address information are acquired by scanning the item of mail. The scanned information is then used to obtain the correct recipient address and the sender's record of the recipient's address is corrected.

5.2 Claims 1-38 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Uhl et al (6,292,709).

5.2.1 In regard to claims 1-38, Uhl et al ('709) disclose a mail processing system that applies both machine readable encoded recipient address information, for example a PDF 417 barcode, and the recipient's address information to an item of mail. The item of mail is then places in the mail delivery system. When an item of mail can not be delivered as addressed, the item of mail is returned to the sender and the machine readable information and recipient address information are acquired by scanning the item of mail. The scanned information is then used to obtain the correct recipient address and the sender's record of the recipient's address is corrected.

5.2.2 Further, the item of mail is transported through the system of Uhl ('709).

6. Response to applicant's arguments.

6.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

6.2 As per the 35 U.S.C. § 101 rejection of claims 19-23, 34 & 35, since:

A) the only mention of the phrase "for controlling a computer system to process" appears in the preamble, this phrase is merely an intended field of use for the computer readable medium which does not breath life and/or meaning into the remainder of the associated claim. Hence, this claim fails to produce a concrete and tangible result and therefore, applicant's argument's are non persuasive.

6.3 As per the 35 U.S.C. § 102 rejection, since applicant failed to address this rejection it has been repeated.

7. The examiner has cited prior art of interest, for example:

A) Sansone (6,549,892) which discloses the assigning of an unique number to an address for the purpose of correcting undeliverable mail.

8. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

9.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

9.2 The fax phone number for OFFICIAL FAXES is (703) 305-7687.

9.3 The fax phone number for AFTER FINAL FAXES is (703) 308-3691.

07/30/03


Edward R. Cosimano
Primary Examiner A.U. 3629